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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,695	06/12/2001	Stephan Heck	H 3172A-PCT/US	6462

23657 7590 09/18/2002

COGNIS CORPORATION
2500 RENAISSANCE BLVD., SUITE 200
GULPH MILLS, PA 19406

EXAMINER

PRICE, ELVIS O

ART UNIT	PAPER NUMBER
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1621

11

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,695

Applicant(s)

HECK ET AL.

Examiner

Elvis O. Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/554,631.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 3 and 4 are pending in the application.
2. Applicants' arguments, filed 4/10/02, were found convincing to overcome the Double Patenting rejection issued in the office action dated 1/16/02.
3. Applicants arguments, filed 4/10/02, were found convincing to overcome the 35 USC 103(a) rejection, for claim 4, issued in the office action dated 1/16/02. However, the 35 USC 103(a) rejection of claim 3 is maintained.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.09/554631, filed on 7/26/00.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being obvious over Koehler et al. {U.S. Pat. 5,672,781}.

Applicants claim a **product** of the said process for the preparation of a mixture of fatty alcohols having an iodine number in the range from 65 to 85 of the formula (I)

R¹OH (I)

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Wherein R^1 is a saturated or unsaturated, linear or branched radical having from 14 to 20 carbon atoms, wherein the process comprises the steps of:

- (a) fractionating palm oil fatty acid methyl esters to produce a first methyl ester fraction comprised substantially of C_{16} esters and a bottom product which is a second methyl ester fraction comprised substantially of unsaturated $C_{16/18}$ esters, and
- (b) hydrogenating the bottom fraction to give the corresponding alcohols under conditions such that the carbon-carbon double bonds remain intact.

Koehler et al. teach a mixture of fatty alcohols having an iodine number in the range from 20 to 110, more preferably 20 to less than 95, and having from 8 to 22 carbon atom aliphatic chain, wherein the aliphatic chain may be saturated or unsaturated, linear or branched. Koehler et al. teach that it is possible to obtain fatty alcohols from palm oil a fatty methyl ester with chain lengths of 16 to 18 carbon atoms as the principle constituents and that the iodine value of the fatty alcohols (**product**) to be produced by the cited process is adjusted by fractionating the methyl esters before hydrogenation (Col. 3 lines 32-53). Fatty alcohols of the formula (I)



Wherein R^1 is a saturated or unsaturated, linear or branched aliphatic radical having from about 8 to about 22 carbon atoms with iodine values from about 20 to about 110 are herein reported in the reference of Koehler et al. (see Col. 1 and 2). The difference between the applicants' claimed invention and the reference is that the range of the

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carbon chain length and the iodine value range of the reference's fatty alcohol products is greater than that of the applicants' fatty alcohol products.

It would have been *prima facie* obvious to one of ordinary skill in the art to obtain fatty alcohols as presently claimed because Koehler et al. teach fatty alcohols of the formula (I),



Wherein R^1 is a saturated or unsaturated, linear or branched aliphatic radical having from about 8 to about 22 carbon atoms with iodine values from about 20 to about 110.

One of ordinary skill in the art would have been motivated to obtain fatty alcohols having an iodine numbers anywhere between 20 and 110, more preferably between 20 to less than 95 because Koehler et al. teach that such fatty alcohols may be used as intermediates to prepare surfactants and cosmetic/skin care products (see Col. 1, lines 43-55 and Col. 2, lines 2-14).

Response to Arguments

Applicants' arguments, filed 4/10/02, are all directed to the process claim rejections and, thus, are not germane to the product-by-process claim rejections.

However, in the event that applicants hold or argue that the process limitations impart patentably distinct qualities to the product, the Examiner would like to remind applicants that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product-by-process claims is the same as or obvious from a product of the prior art,

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the claim is unpatentable even though the prior product was made by a different process (see *In re Thorpe*, 227 USPQ 964).

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: Claim 4 is unobvious over the prior art of record because the prior art or record does not teach or suggest a process according to the claimed invention, whereby a fraction of methyl esters obtained from palm oil fatty acid is first separated into saturated and unsaturated fractions prior to hydrogenation.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

Elvis O. Price, Ph.D.

September 12, 2002


Johann R. Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600